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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/722,898	11/26/2003	Lane Smith	P-103786.3 (UTI)	2886

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EXAMINER	
QIN, JIANCHUN	

ART UNIT	PAPER NUMBER
2837	

DATE MAILED: 11/16/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

AFC

Office Action Summary	Application No.	Applicant(s)	
	10/722,898	SMITH ET AL.	
	Examiner	Art Unit	
	Jianchun Qin	2837	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *19 September 2005*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *8,11 and 13-17* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *8,11 and 13-17* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Response to Amendment

1. The terminal Disclaimer filed on 09/19/2005 has been disapproved, because:

The patent number to which the instant application was double patenting with was incorrect on the terminal disclaimer.

Double Patenting

2. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970);and, *In re Thorington,* 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

3. Claims 13-17 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 11-17 of U.S. Patent No.

6,530,577. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims of the instant application recite the same manufacturing method for a layered sheet. The intended use of the sheet does not carry any patentable weight.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 8 and 11 are rejected under 35 U.S.C. 102(b) as being anticipated by Behrenfeld (5,986,196).

Regarding claim 8, Behrenfeld discloses a device comprising: a patch (22, 29) comprising a resilient, pliable, adhesive body (22) and an integral flexible base (29); and a second patch (18), the second patch for stacking on the first patch, the first patch for attaching to the vibratable surface (8).

Regarding claim 11, Behrenfeld discloses the claimed invention. See above and Fig. 2A.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

7. Claims 13-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fyfe (6,806,212) in view of Iiyama et al. (JP02003001648A, machine English translation).

Regarding claim 13, Fyfe discloses the method steps of providing a flat surface (101); applying a polyurethane mix (27, col. 4, line 23, and Fig. 1) to the flat surface, laying a sheet (26) of base material onto the polyurethane mix (Fig. 1), and allowing the polyurethane mix to cure (inherence to the process).

Fyfe does not mention expressly: releasing the cured polyurethane mix and base material from the flat surface.

Iiyama et al. disclose a method and apparatus for producing polyurethane sheet, and teach the step of providing a release sheet (2) underneath the polyurethane mix (sections 0028, 0029 and 0034), and releasing the polyurethane mix and base material from the release sheet polyurethane mix is cured (Abstract).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to incorporate the teaching of Iiyama et al. in the invention of Fyfe in order to provide a technically convenient and robust method for producing a

polyurethane sheet that contains a polyurethane layer coated on a base material for various usages (Iiyama et al., Abstract and section 0015).

Regarding claims 14-16, Iiyama et al. teach: providing a release sheet (sections 0028, 0029); removing any tapped air from the mix prior to curing (sections 0044 and 0045); cutting the cured/mixed sheet to a pre-selected shape (section 0049).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to incorporate the teaching of Iiyama et al. in the invention of Fyfe in order to provide a technically convenient and robust method for producing a polyurethane sheet that contains a polyurethane layer coated on a base material for various usages (Iiyama et al., Abstract and section 0015).

Regarding claim 17, the teaching of Iiyama et al. includes: said pre-selected shape is a rectangle (section 0049).

Iiyama et al. do not mention said rectangle has an area between about 1 sq. inch and 12 sq. inches. However, it would have been obvious to one having ordinary skill in the art at the time the invention was made to choose an optimum value for the size of the rectangle, since it has been held that discovering an optimum value of a result effective variable involves only routine skill in the art. *In re* Boesch, 617 F.2d 272, 205 USPQ 215 (CCPA 1980).

Conclusion

8. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP §

706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Response to Arguments

9. Applicant's arguments filed 09/19/05 with respect to claims 8 and 11 have been fully considered but they are not persuasive.

Applicant argued that "None of the properties of the Behrenfeld foam sheet show adhesiveness, resilience or pliability". This argument is not persuasive. The Examiner's position is that, given the claims the broadest reasonable interpretation, the Behrenfeld reference discloses or teaches or suggests all the subject matter recited in these claims. The examiner reminds to the Applicant that during patent examination, the pending claims must be given the broadest reasonable interpretation consistent with the specification. Applicant always has the opportunity to amend the claims during

prosecution, and broad interpretation by the examiner reduces the possibility that the claim, once issued, will be interpreted more broadly than is justified. *In re Prater*, 415 F.2d 1393, 1404-05, 162 USPQ 541, 550-51 (CCPA 1969). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

10. Applicant's arguments with respect to claim 13 has been considered but are moot in view of the new ground(s) of rejection.

Claim 13 and subsequent dependent claims 14-17 are rejected as new prior art reference (JP02003001648A to Iiyama et al.) has been found to teach the limitation added in the amended claims. Detailed response is given in section 7 as set forth above in this Office Action.

Contact Information

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jianchun Qin whose telephone number is (571) 272-5981. The examiner can normally be reached on 8:00am - 5:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Martin can be reached on (571) 272-2107. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for

published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Jianchun Qin
Examiner
Art Unit 2837

JQ
November 10, 2005

DAVID MARTIN
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